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MS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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000134 11/27/99 FALCONHILL

EXAMINER
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000134 INS2/0214  
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ART UNIT	PAPER NUMBER
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SHERRE, C

DATE MAILED:  
1761

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02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No. <b>09/423,665</b>	Applicant(s) <b>Falconnier</b>
Examiner <b>Curtis E. Sherrer</b>	Group Art Unit <b>1761</b>



☒ Responsive to communication(s) filed on Dec 5, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### Part III DETAILED ACTION

This Detailed Action is a Substitute Office Action. The Preliminary Amendment of 11/22/99 had not previously been entered and acted upon when the last Office Action was issued.

#### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Drawings*

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### *Specification*

3. The disclosure is objected to because of the following informalities: The term "anethol" should be spelled --anethole--.

Appropriate correction is required.

4. Claims 1-19 are objected to because of the following informalities: The term "anethol" should be spelled --anethole--. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

5. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a beverage that has improved solubility (non-cloudy) of anethole, does not reasonably provide enablement for beverages that do not rely on the use of a micro or submicron emulsion (see page 4, bottom). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The claims' preambles use the unconventional phrase "characterized in that" rather than "comprises," "consists of," or "consisting essentially of."

9. Claim 1 is indefinite because the scope of the phrases "acceptable in human food" and "apparent solubility" is unknown.

10. Claim 2 is indefinite because it is not clear if the phrase "especially lysolecithins" is a limitation upon the claim.

11. Claim 2 is indefinite because the scope of the phrase "derivatives thereof" is unknown.

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12. Claim 5 is indefinite because it is not clear how the phrase "in particular" limits the claim.

13. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "preferably" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 6, 8 and 18 recite the broad recitation of the concentration of anethol and alcohol, respectively, and the claims also recite a narrower statement of the range/limitation.

14. Claim 11 is indefinite because the scope of the phrase "antioxidant substances" is unknown.

15. Claim 13 is indefinite because it is unclear if the limitation is directed to claiming a cloudy beverage or a characteristic that the claimed beverage possesses.

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16. Claim 15 is indefinite because it is unclear if the items listed in the brackets are actual limitations.

17. Claim 16 is indefinite because it contains terms within brackets and it is not clear if these terms are positive limitations. Further, the scope of "etc." is unknown.

18. Certain claims, such as claims 8 and 18, recite a limitation directed to an ethanol concentration and it is unclear how the preamble can be directed to a non-alcoholic beverage.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-8 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brun et al. (U.S. Pat. No. 4,944,956).

21. Brun et al teach the production of an alcoholic beverage as claimed (see Abstract) except that the surfactant does not appear to be the claimed phospholipid, but rather a food grade surfactant whose hydrophilic/lipophilic balance is between 12 and 15, whose critical micellar concentration is between  $10^{-1}$  and  $10^{-3}$ , and whose haze point is greater than  $30^{\circ}$  C for a nonionic surfactant and the Krafft temperature being less than  $10^{\circ}$  C for an ionic surfactant. While it is

not clear that any and all phospholipids fall outside the above grouping of characteristics. because the instant application is assigned to the same entity as the assignee of Brun et al. it is assumed that phospholipids are outside of the above characteristics.

22. Lecithin (and derivatives thereof), the preferred phospholipid, is a notoriously well known food grade emulsifier, i.e., surfactant. To replace the prior art surfactant with a well known surfactant, such as lecithin, would have been obvious to one of ordinary skill in the art to replace one well known surfactant with another well known surfactant. An express suggestion to substitute one equivalent component for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

23. Applicant also claims certain ranges for the amount of lecithin and these ranges would be obvious as the amount of lecithin is a result effective variable and therefore would be optimized by those of ordinary skill in the art to obtain the desired emulsion characteristics.

24. Applicant also claims the use of antioxidants, such as tocopherol or tea extracts. These are notoriously well known and used in the food art and it would have been obvious to those of ordinary skill in the art to use said additives for their art recognized functions.

25. Similarly, Applicant claims the inclusion of phenolic substances, such as licorice, cola, tannins, grape extracts, etc., most of which are used in the food art for various reasons, such as flavorings, etc. Their use in the prior art beverage is would have been obvious to those of ordinary skill in the art to use said additives for their art recognized functions.

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26. Finally, Applicant's attention is invited to *In re Levin*, 84 U.S.P.Q. 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 U.S.P.Q. 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 U.S.P.Q. 221.

27. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brun et al. in view of Kirk (U.S. Pat. No. 4,966,779).

28. Brun et al teach that cited above but are silent as to whether the emulsion is micronised. Kirk teaches the production of water miscible emulsion using a modified lecithin that is produced for the food industry in size of 0.5 microns that is stable. It would have been obvious to those of ordinary skill in the art to micronise the emulsion of the prior art in order to enhance the stabilization of the food product. Again, see *In re Levin*.

### ***Conclusion***



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29. No claim is allowed.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

31. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'C. E. Sherrer', with a stylized, flowing script.

Curtis E. Sherrer  
Primary Examiner  
February 9, 2001